

Applicants Provisionally Elect With Traverse

Claims 1-27 are pending. In response to the Office Action dated April 4, 2007 requiring restriction election, Applicants provisionally elect with traverse Group II (claims 12-26). Applicants respectfully submit that claims 1-11 and 27 (as currently amended) also correspond to Group II. The Action's comments (on page 3) regarding species election are unclear. Reconsideration and withdrawal of the restriction requirement are respectfully requested.

MPEP § 806.05 states that "The burden is on the examiner to provide reasonable examples that recite material differences." Applicants respectfully submit that the Office has not met the prerequisite criteria for insisting on restriction requirement, especially in light of the claim amendments. The Office has not established that the process can be practiced by a materially different apparatus. Nor has the Office established that the apparatus can be used in a materially different process. The Office has not shown the alleged Groups to be distinct. Thus, the reason provided for insisting on restriction is not valid. Therefore, Applicants respectfully submit that the restriction requirement should be withdrawn.

MPEP § 803 sets forth criteria for a proper restriction requirement. One of the criteria is that there must be a "serious burden" on the examiner in order for restriction to be required. Conversely, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits. Applicants respectfully submit that the requirement is further not legally proper because the criteria for serious burden has not been met.

Rejoinder

The Action has not addressed the issue of rejoinder of claims (MPEP § 821.04). Thus, the Action is incomplete. Applicants respectfully submit that even if the claims were somehow directed to different Groups as alleged, that claims would still be entitled to rejoinder. Applicants reserve all rights to rejoinder.

The Restriction Requirement Is Without Legal Basis

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being “distinct.” The statutory authority for the Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Office may require restriction, the inventions must be both “independent” and “distinct.” The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct. Applicants respectfully disagree with the Office's interpretation of independent and distinct as set forth in MPEP § 802.01.

In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

Furthermore, the Office has acknowledged that before claimed inventions can be considered to be "independent" the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. The Office has not established that all of the claims are not related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.

Conclusion

Applicants respectfully submit that the restriction requirement is not legally proper and should be withdrawn. The undersigned is willing to discuss any aspect of the application.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000